

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-7, 9-14 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (Patent # US 5671267) in view of Kameo et al. (Patent # US 4899370).

As to claim 1, August discloses a method of controlling a set top box comprising:  
providing a set top box that can be controlled by a telephone line coupled to the set top box (e.g., the base unit 20 could contained in the set top box 32) (see col. 9, lines 47-55; col. 10, lines 20-25, 45-65; Fig. 5);

receiving a telephone call from a calling party via the telephone line (see col. 10, lines 45-65);

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to a television event in accordance with the at least one command (e.g., the

Art Unit: 2426

user programs the set top box receiving (or not receiving) certain channels by entering the predetermined codes) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

wherein the telephone line is directly coupled to the set top box (e.g., line 34; Fig. 5),

wherein the receiving of the telephone call is performed by the set top box (see col. 10, lines 17-44), and

wherein the at least one command is transmitted directly to the set top box (e.g., the user remotely programs the set top box by a telephone call, the set top box is receiving the commands over the phone call) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

August does not specifically disclose the command includes directing the set top box to tune to a television event by the calling party.

August discloses the number keys are used to enter a desired channel number and the left and right arrows keys are for channel up/down. August also discloses a user can remotely control the same function from his or her residence. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention that August discloses a user could remotely (e.g., by calling) access the set top box and send channel change commands to the set top box (i.e., ordering the set top box tuning to certain channels or not tuning to by enter the predetermined codes via the telephone) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

In fact, Kameo discloses the command includes directing the device to tune to a television event by the calling party (see col. 1, lines 31-35; col. 4, line 46-col. 5, line 24; col. 7, line 47-col. 8, line 13; Fig. 3 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the tuning command including in the remote control functions as taught by Kameo to the system of August in order to provide a set top box that allows user to fully control of the set top box over a telephone call without physically local with the device.

As to claim 12, August discloses an apparatus adapted to employ a telephone interface (e.g., set top box 32; Fig. 5) comprising:

a processor (e.g., control unit 210; Fig. 2) comprising computer program code adapted to control a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call (e.g., the base unit 20 could contained in the set top box 32) (see col. 9, lines 47-55; col. 6, lines 35-51; col. 7, lines 1-11), the controlling including directing the set top box to a television event in accordance with the at least one command (e.g., the user programs the set top box receiving (or not receiving) certain channels by entering the predetermined codes) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

wherein the telephone line is directly coupled to the set top box (e.g., line 34; Fig. 5),

wherein the at least one command is transmitted directly to the set top box (e.g., the user remotely programs the set top box by a telephone call, the set top box is receiving the commands over the phone call) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

August does not specifically disclose the command includes directing the set top box to tune to a television event by the calling party.

August discloses the number keys are used to enter a desired channel number and the left and right arrows keys are for channel up/down. August also discloses a user can remotely control the same function from his or her residence. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention that August discloses a user could remotely (e.g., by calling) access the set top box and send channel change commands to the set top box (i.e., ordering the set top box tuning to certain channels or not tuning to by enter the predetermined codes via the telephone) (see col. 7, lines 15-22; col. 8, lines 12-17, 55-62; col. 9, lines 23-46; col. 10, lines 45-65; Fig. 2, 3, and 5).

In fact, Kameo discloses the command includes directing the device to tune to a television event by the calling party (see col. 1, lines 31-35; col. 4, line 46-col. 5, line 24; col. 7, line 47-col. 8, line 13; Fig. 3 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the tuning command including in the remote control functions as taught by Kameo to the system of August in order to provide a set

Art Unit: 2426

top box that allows user to fully control of the set top box over a telephone call without physically local with the device.

As to claim 14, it contains the limitations of claim 1 and is analyzed as previously discussed with respect to claim 1 above.

As to claim 2, August discloses the method of claim 1 wherein controlling the set top box via at least one command transmitted by the calling party comprises receiving at least one predetermined number dialed by the calling party (e.g., number 0-9 for channel number) (see col. 8, lines 13-17; col. 10, lines 45-65; Fig. 3).

As to claims 3 and 4, August discloses the method of claim 1 wherein controlling the set top box comprises disabling and enabling the set top box (e.g., user can remotely enable or inhibit channels or signals reaching video receiving device 60; Fig. 5) (see col. 10, lines 45-65).

As to claim 5, August discloses the method of claim 1 wherein controlling the set top box comprises directing the set top box to decrease a volume of a television set coupled to the set top box (see col. 2, lines 56-64).

As to claim 13, claim 1 meets the limitation.

Art Unit: 2426

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Kameo et al. (Patent # US 4899370), further in view of Doganata et al. (Patent # US 6772436 B1).

As to claim 6, note the discussion above, August and Kameo fail to specifically disclose using the television speaker for telephone speaker.

Doganata discloses the set top box to transmit an audio signal from the calling party over a speaker of the television set (see col. 4, lines 54-67; Fig. 1 and 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to using television speaker for telephone as taught by Doganata to the remotely control set top box of August because it enables TV viewers to participate in audio conferences that are linked to the programs that they are watching, without the need to dial in to a conference call (see col. 2, lines 15-18)

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Kameo et al. (Patent # US 4899370), further in view of Ellis et al. (Pub # US 2005/0028208 A1).

As to claim 7, note the discussion above, August and Kameo fail to specifically disclose playing the television audio over the telephone.

Ellis discloses directing the set top box to play at least an audio portion of a television event over the telephone line (see paragraph 0094, 0133; Fig.1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to play television audio as taught by Ellis to the remotely control set top box of August because it provides a program guide system that allows a user to adjust to the user settings of a plurality of program guides at different locations within a household from a single location (see paragraph 0013).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Kameo et al. (Patent # US 4899370), further in view of Schuchman et al. (Patent # US 5640453).

As to claim 9, note the discussion above, August and Kameo fail to specifically disclose directing the set top box to record a television event.

Schuchman discloses controlling the set top box comprises directing the set top box to record a television event (see col. 3, lines 29-36; Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control VCR through set top box as taught by Schuchman to the remotely control set top box of August because the subscriber's set-top box could command storage devices to record video services and a controlled data stream from the storage device and simplify the control (see col. 2, lines 38-42)

As to claim 10, Schuchman discloses the method of claim 9 wherein directing the set top box to record a television event comprises directing the set top box to transmit a record command to a video recording device (see col. 3, lines 29-36).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Kameo et al. (Patent # US 4899370), further in view of Brodigan (Patent # US 6219355 B1).

As to claim 11, note the discussion above, August and Kameo fail to specifically disclose directing the set top box to play a telephone message.

Brodigan discloses controlling the set top box comprises directing the set top box to play a telephone message previously recorded by the set top box (e.g., replay voice messages) (see col. 5, lines 31-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide voice message as taught by Brodigan to the remotely control set top box of August because provide a much needed simplification of services, such as a customer may review voice messages, or even order an additional telephone line or change phone services with their set top box (see col. 2, lines 55-65).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-7, 9-14 have been considered but are moot in view of the new ground(s) of rejection.



Although a new ground of rejection has been used to address additional limitations that have been added to claims 1, 12 and 14, a response is considered necessary for several of applicant's arguments since August reference will continue to be used to meet several claimed limitations.

August discloses "Integration of the control functions into one common device advantageously allows for interaction of desirable activities automatically. By way of example, when a ringing signal representative of an incoming telephone call is received over the tip-ring line 34 to which the set-top box 32 is connected, the set-top box is able to display on the video receiving device 60 a video message which provides the identity of the calling party" (col. 10, lines 20-26), which meets the limitations "*wherein the telephone line is directly coupled to the set top box, wherein the receiving of the telephone call is performed by the set top box*".

August further discloses "user who is located remote from his or her residence. For this operation the user calls his or her telephone number and accesses the set-top box 32 for configuring this unit as desired. By entering the predetermined codes, the user is again able to enable or inhibit certain channels or signals from reaching video receiving device 60" (see col. 10, lines 59-65) and "Also, circuitry contained in the set-top box 32 may include the circuitry and interfaces associated with the handset unit 10 in FIG. 2 and thus provide the same features and functions available from this handset unit" (see col. 9, lines 43-47). Thus, user can remotely control the set top box via a telephone call and also the set top box could operate without the handset unit 10, because those circuitry and interfaces are contained in the set top box 32. Since the

Art Unit: 2426

set top box is the one receiving telephone call, the command is directly received by the set top box.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Inter alia, applicant's arguments are persuasive.

### ***Conclusion***

9. Claims 1-7, 9-14 are rejected.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2426

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakano et al. (Patent # US 5901366) is cited to teach using cordless telephone selecting video program.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUN FEI ZHONG whose telephone number is (571)270-1708. The examiner can normally be reached on M-F, 7:30~5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on 571-272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2426

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ  
11/5/2010

/Joseph P. Hirl/  
Supervisory Patent Examiner, Art Unit 2426  
November 8, 2010